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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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|-----------------|-------------|----------------------|---------------------|

09/336,266 06/14/99 BEMIS

G VPI/96-16.CI

HM12/0127

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EXAMINER

RAQ,D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1611

DATE MAILED:

01/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/336,266

Applicant(s)

Bemis et al.

Examiner

Deepak Rao

Group Art Unit

1611



☒ Responsive to communication(s) filed on Jun 14, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-37 ☒ are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-37 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claims 1-37 are pending in this application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 4-15 (all in part), 16-17 and 25-37 (in part), drawn to compounds of formulae (Ia) and (Ic) wherein both Y's are carbons and A is N, corresponding composition and method of use, classified in class 544, subclass 234+.
- II. Claims 1-2, 4-13 and 25-37 (all in part), drawn to compounds of formulae (Ia) and (Ic) wherein one of the Y's is a carbon and the other is nitrogen and A is N, classified in class 544, subclass 250+.
- III. Claims 1-2, 4-13 and 25-37 (all in part), drawn to compounds of formulae (Ia) and (Ic) wherein both Y's are N and A is N, corresponding composition and method of use classified in class 544, subclass 179.
- IV. Claims 1-2, 4-12, 14-15 and 25-37 (all in part), drawn to compounds of formulae (Ia), (Ib), (Ic) and (Id) wherein both Y's are carbons and in case of formulae (Ia) and (Ic), A is CR', corresponding composition and method of use, classified in class 544, subclass 252+.
- V. Claims 1-2, 4-12 and 25-37 (all in part), drawn to compounds of formulae (Ia), (Ib), (Ic) and (Id) wherein one of the Y's is carbon and the other is nitrogen and in

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case of (Ia) and (Ic), A is CR', corresponding composition and method of use, classified in class 544, subclass 251.

- VI. Claims 1-2, 4-12 and 25-37 (all in part), drawn to compounds of formulae (Ia), (Ib), (Ic) and (Id) wherein both Y's are carbons and in case of formulae (Ia) and (Ic), A is CR', corresponding composition and method of use, classified in class 544, subclass 255+.
- VII. Claims 3-13, 18-21 and 25-37 (all in part), drawn to compounds of formulae (Ie) and (If) wherein both Y's are N, A is N and n is 1 (tetrazines), corresponding composition and method of use, classified in class 544, subclass 179.
- VIII. Claims 3-13, 18-21 and 25-27 (all in part), drawn to compounds of formulae (Ie) and (If) wherein one of Y's is carbon and the other is nitrogen, A is N and n is 1 (triazines), classified in class 544, subclass 180+.
- IX. Claims 3-15 and 18-37 (all in part), drawn to compounds of formulae (Ie) and (If) wherein both Y's are carbons, A is N, n is 1 (diazines), corresponding composition and method of use, classified in class 544, subclass 224+.
- X. Claims 3-12, 14-15 and 18-37 (all in part), drawn to compounds of formulae (Ie) and (If) wherein both Y's are carbons, A is CR' and n is 1 (pyridines), corresponding composition and method of use, classified in class 546, subclass various.

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- XI. Claims 3-12, 18-21 and 25-37 (all in part), drawn to compounds of formulae (Ie) and (If) wherein both Y's are nitrogens and n is 0 (triazoles), corresponding composition and method of use, classified in class 548, subclass 262.2+.
- XII. Claims 3-12, 18-21 and 25-37 (all in part), drawn to compounds of formulae (Ie) and (If) wherein one of the Y's is carbon and the other is nitrogen, n is 0 (diazoles), corresponding composition and method of use, classified in class 548, subclass 300.1+.
- XIII. Claims 3-12, 14-15 and 25-37 (all in part), drawn to compounds of formulae (Ie) and (If) wherein both Y's are carbons and n is 0 (pyrroles), corresponding composition and method of use, classified in class 548, subclass 400+.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I-XIII are drawn to structurally dissimilar compounds. They are made independently and used independently. They would be expected to raise different issues of patentability if a compound of Group I were anticipated, the anticipatory reference would not necessarily render obvious the other groups II-XIII or vice-versa. Inventions of groups I-VI are drawn to bicyclic compounds and groups VII-XIII are drawn to monocyclic compounds. They are not art recognized equivalents, they are classified diversely from classes 544-548/various subclasses and require separate burdensome searches both in the literature and computer databases.

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Inventions VI-XIII and I-VI are related as mutually exclusive species in an intermediate-final product relationship (see Scheme 3 in page 26). Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is also deemed to be useful as P38 inhibitors and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and as shown by their different classification, restriction for examination purposes as indicated is proper.

In addition to the election of a single group, applicant is also required to elect a single species within the group.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Mr. Nandakumar Govindaswamy on January 13, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made. Mr. Govindaswamy requested that the restriction be set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Rao whose telephone number is (703) 305-1879. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status

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of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Mukund J. Shah

Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1611

Deepak Rao *[Signature]*
January 19, 2000